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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,500	07/23/2003	Shuzo Fujiwara	Q76345	7841

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EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

•Application No.

10/624,500

Applicant(s)

FUJIWARA ET AL.

Examiner

Donald Loney

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☒ Other: See Continuation Sheet.

Continuation of Attachment(s) 6). Other: copy of english translation of DE3710670.

DETAILED ACTION***Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 1-9 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-13 of U.S. Patent No. 6773806 in view of any of Melbye (4604153) Harvie et al (5693405) or Aakermann (6680098).

US Pat. No 6773806 claims an adhesive tape comprising polyolefin resin copolymer formed by multistage polymerization comprising two steps (i.e. a block copolymer). It does fail to teach characters or designs formed of protrusions and/or recesses (i.e. indicia).

All of the secondary references teach to form indicia on a plastic film in order to be able to provide indicating means thereon. Refer to figures 7 and 8 in Melbye. Refer to figures 4 and 5 in Harvie et al that show a raised logo (34,53). This reference is

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particularly pertinent since layer 42 can be an adhesive layer (column 7, lines 32-34), therefore directly showing the embossing in the backing layer as recited by the applicant. Refer to figure 1 showing indicia 12, 13 on a backing layer 9 or 10 of a label (i.e. tape like structure) along with column 5, line 21 through column 6, line 24. Layer 9' can be an adhesive layer, which then forms a tape structure as recited (i.e. backing layer and adhesive layer).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to US Pat. No. 6773806 to include characters and/or designs in the backing layer of the tape, as shown by the secondary references, in order to provide indicating indicia thereon motivated by the fact that the secondary references teach this is a desired property in backing layers of tapes.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nakagawa et al (6586090) in view of any of Melbye (4604153) Harvie et al (5693405) or Aakermann (6680098).

Nakagawa et al discloses an adhesive tape comprising polyolefin resin copolymer formed by multistage polymerization comprising two steps. Flame retardants

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are also taught. Refer to the Abstract, column 6, lines 62-65 and the claims. It does fail to teach characters or designs formed of protrusions and/or recesses (i.e. indicia).

All of the secondary references teach to form indicia on a plastic film in order to be able to provide indicating means thereon. Refer to figures 7 and 8 in Melbye. Refer to figures 4 and 5 in Harvie et al that show a raised logo (34,53). This reference is particularly pertinent since layer 42 can be an adhesive layer (column 7, lines 32-34), therefore directly showing the embossing in the backing layer as recited by the applicant. Refer to figure 1 showing indicia 12, 13 on a backing layer 9 or 10 of a label (i.e. tape like structure) along with column 5, line 21 through column 6, line 24. Layer 9' can be an adhesive layer, which then forms a tape structure as recited (i.e. backing layer and adhesive layer).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Nakagawa et al to include characters and/or designs in the backing layer of the tape, as shown by the secondary references, in order to provide indicating indicia thereon motivated by the fact that the secondary references teach this is a desired property in backing layers of tapes.

4. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over any of any of JP 05-194915, JP 025-047249, JP 05-345881, WO 97/05206, Tucker et al (5498476) or DE 3710670 to Grab et al in view of Inata et al, the applicants' discussion of the prior art and any of Melbye (4604153) Harvie et al (5693405) or Aakermann (6680098).

Grab et al discloses a recyclable pressure sensitive tape comprising a polyolefin base material and an inorganic flame retardant. Refer to pages 6-13 of the English translation supplied by the examiner. Refer to the Abstracts of the three JP references along with the applicants' discussion thereof on pages 2 and 3 in the IDS filed July 23, 2003. Refer to Abstract and pages 2-4 in WO 97/05206. Refer to Abstract and column 4, line 10 through column 5, line 67. The primary references do fail to teach a polyolefin resin copolymer formed by multistage polymerization comprising two steps (i.e. a block copolymer) as the base material. The primary references do teach various copolymers and Grab et al specifically discloses ethylene propylene copolymers ((page 6 last paragraph). Grab et al also discloses that the surface can be structured 5 by embossing (figure 2).

Inata et al discloses that polyolefin block copolymers, with fire retardants, and containing no halogens are known to be used for their fire retardant properties, and have less toxicity. Refer to the Abstract, Summary of the Invention, column 1, lines 5-7, column 2, lines 28-37 and column 3, lines 7-25. The applicant on page 12, last paragraph through the first full paragraph on page 13 discloses that the block copolymers are known.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to the primary references to use the known block copolymers for the base since these copolymers are known to be used for their fire resistance and the fact they are less toxic. With respect to the designs being drawn to recycling information it would have been obvious to one having ordinary skill in the art to

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provide indicating this type of indicia motivated by the fact that the secondary references teach this is a desired property in backing layers of tapes. It is known from containers (e.g. milk jugs) to have a protruding symbol indicating recyclability.

Response to Arguments

5. Applicant's arguments with respect to claims 1-9 have been considered but are moot in view of the new ground(s) of rejection. Applicant's arguments filed October 7, 2005, have been fully considered and are persuasive. The previous rejection of claims 1-9 has been withdrawn.

Conclusion

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on 571 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Donald Loney
Primary Examiner
Art Unit 1772

DJL;D.Loney
12/20/05